

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant (s) : Tadayoshi OKADA et al.
Serial No. : 10/663,060
Filed : September 12, 2003
Examiner : Katcheves, Basil S.
Group Art Unit : 3635
For : HIGH-STRENGTH BOLTED CONNECTION STRUCTURE
WITH NO FIRE PROTECTION

I hereby certify that this paper for S/N 10/663,060 is being facsimile
transmitted to 571-273-8300 at the United States Patent & Trademark
Office on the date indicated below

January 3, 2007

Date of Deposit

Manu J Tejwani 37,952

Attorney Name PTO Reg. No.

M. Tejwani January 3, 2007

Signature Date of Signature

REQUEST FOR RECONSIDERATION OF
SECOND RENEWED PETITION TO WITHDRAW HOLDING OF ABANDONMENT
UNDER 37 C.F.R. §1.181(a)

Mail Stop **PETITION**
Commissioner for Patents
Alexandria, VA 22313-1450

ATTN: PAUL SHANOSKI, SENIOR ATTORNEY
OFFICE OF PETITIONS

Sir:

Applicants respond to the "Decision on Renewed Petition under 37 C.F.R. 1.181(A)" and Petitions under 37 C.F.R. §§ 1.137(B), 1.182, and 1.1.83 mailed on October 2, 2006 ("October Decision").

In their Renewed Petition filed September 1, 2006 (“Renewed Petition”), which incorporated by reference earlier Petitions, applicants respectfully requested withdrawal of the holding of abandonment, revival of the application, and processing of the RCE filed January 9, 2006. Further applicants respectfully requested waiver of fees associated with the filing of the petition and alternate petitions therein.

Applicants appreciate that the October Decision withdraws the holding of abandonment, subsequent to which the application is revived and being processed by the Examiner. However, the October Decision charged applicants fees of \$ 400 for the 37 C.F.R. § 1.182 petition, \$ 400 for the 37 C.F.R. § 1.183 petition, \$1500 for the 37 C.F.R. § 1.137 petition. Applicants respectfully request reversal of these fees based on reconsideration of their Renewed Petition and earlier Petitions incorporated by reference therein.

Unusual Situations Not Specifically Provided For In The Regulations/ And Extraordinary Situation Meriting Waiver Of The Rules, Sua Sponte, Or On Petition Of Interested Party.

Applicants note that the October Decision (unlike the less explicit earlier July Decision) explicitly asserts: “October 19, 2005: After-final Amendment and one month extension of time are submitted to the Office (submission is *not* received, but bears certificate of facsimile transmission.” (emphasis added) (See October Decision page 5, ¶ 3).

Applicants respectfully disagree. As previously noted in Applicants’ Original Petition under 37 C.F.R § 1.181(a), which was mailed together with the RCE filing on January 9, 2006, the Examiner indicated in a telephone call on or about even date to the undersigned that “he did indeed receive the Reply via facsimile on October 19, 2005, but did not attend to it.” The undersigned further submits that the Examiner indicated that the Reply was physically in his

possession on his Patent Office computer on the date of the aforementioned telephone call.

Applicants' respectfully submit that this situation where the Examiner receives the Reply and does not attend to it is not covered by the rules. The undersigned understands the rules and regulations lay the burden on the applicants for ensuring means for timely delivery of a Reply to Final Office Action by the six month date or bear the risk of abandonment. However, applicants respectfully submit that the rules and regulations are only intended to cover applicants' failure or third party failure (e.g., mail room or mail service failure). The rules and regulations, respectfully, do not cover or excuse failure by a U.S. Patent and Trademark Office principal to attend to the timely delivered Reply (as admitted to by the Examiner). Applicants note, for example, 37 C.F.R. § 1.8(b), which is cited on page 2 of the October Decision, refers only to informing "after becoming aware that the Office has no evidence of its receipt of the correspondence." Here, the Office did have evidence of its receipt as admitted by the Examiner, which was previously noted in Applicants' January 9, 2006 Original Petition. Thus, the instant case, in which the Examiner receives the Reply and does not attend to it, is an "Unusual Situation" not specifically provided for in the Regulations under 37 C.F.R. § 1.182, and an "Extraordinary Situation" that merits waiver of the rules, *sua sponte*, or on petition of interested party, under 37 C.F.R. 1.183.

Accordingly, applicants respectfully request reconsideration and reversal of the fees charges for 37 C.F.R. §§ 1.137(B), 1.182, and 1.1.83 petitions in this case.

Advisory Action and Notice of Abandonment

For completeness, the undersigned also presents additional comments on the (1) Advisory Action accompanying March 16, 2006 decision on the Original Petition ("March 16

Advisory Action”), and (2) a Notice of Abandonment dated August 15, 2006, which only reinforces applicants’ submission that the processing of this application is an Unusual Situation/Extraordinary Situation.

March 16 Advisory Action.

The March 16 Advisory Action item # 7 indicates that “[F]or purposes of appeal” the proposed claims would be entered, without providing any appended explanation of how the new or amended claims would be rejected.

In the Renewed Petition, the undersigned characterized the March 16 Advisory Action negatively, *iter alia*, as perfunctory, hurried and without proper examination. This negative characterization was, and is, not directed to person or persons, but to the Advisory Action itself. Therefore, the undersigned regrets that the October Decision states that “[the] assessment . . . is not well taken,” and calls out for applicants (i.e. a Patent Office customer) to cite authority for expecting any better Advisory Action explanation of how the new or amended claims would be rejected.

In this respect, the undersigned cites the following authorities:

- (1) Implied regulations arising from Patent Office’s regular business practice: In the undersigned’s experience, every Advisory Action received from the Patent Office has been (a) dated and signed, and (b) accompanied, at the bottom of page 1 or on appended page 2, an explanation that at least mentions, however briefly, a reason for maintaining the rejection or not entering the proposed claims.
- (2) MPEP § 1207 (April 2000), which states: “If the examiner indicates (in the advisory action) that a proposed amendment of the claim(s) would be entered for

purposes of appeal, it is imperative for the examiner to also state (in the same advisory action) how the individual rejection(s) set forth in the final Office action will be used to reject the added or amended claim(s) in the examiner's answer."

(2) MPEP § 714.13 (April 2000), which states: "Whenever such an amendment is entered for appeal purposes, the examiner must indicate on the advisory action which individual rejection(s) set forth in the action from which the appeal was taken (e.g., the final rejection) would be used to reject the new or amended claim(s)" and "Advisory Action Before the Filing of an Appeal Brief form PTOL-303 . . . has been devised to advise applicant of the disposition of the proposed amendments to the claims and of the effect of any argument or affidavit not placing the application in condition for allowance . . ." (underlining added).

The October decision does not address the lack of explanation of the claim rejections in the March 16, 2006 required by the very language of the first sentence of # 7, but instead refers to the second sentence of #7, which relates to the status of claims but not to the required explanation.

Notice of Abandonment mailed August 15, 2006

Applicants draw attention to a Notice of Abandonment mailed August 15, 2006, (copy attached), which only reinforces applicants' belief that the processing of their application has been unusual and extraordinary, which merits waiver of the rules by the Office of Petitions.

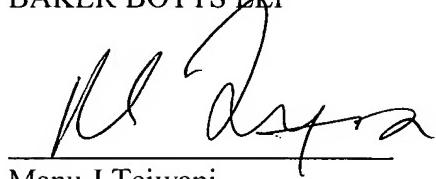
The Notice of Abandonment refers to applicant's failure to file a proper reply to the Office Letter dated 18 January 2006.

The undersigned, on receipt of the Notice, filed a Response dated September 1, 2006 (copy attached) requesting clarification as no Office Letter dated 18 January 2006 was received or is recorded on PAIR. The undersigned further notes that to his best information neither the Notice of Abandonment mailed August 15, 2006 nor the Response dated September 1, 2006 is recorded on PAIR as of this date.

In consideration of the above items, applicants respectfully request waiver and reversal of the various petition fees charged in connection with this petition and the alternate petitions herein.

Respectfully submitted,

BAKER BOTTS LLP

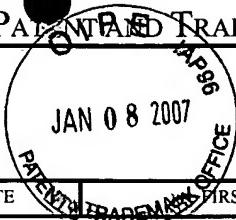


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New York NY 10112



UNITED STATES PATENT AND TRADEMARK OFFICE



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,060	09/12/2003	Tadayoshi Okada	A35998-074224.0118	1995
21003	7590	08/15/2006		

BAKER & BOTTS
30 ROCKEFELLER PLAZA
44TH FLOOR
NEW YORK, NY 10112

BAKER BOTTS LLP
RECEIVED

AUG 21 2006

EXAMINER

KATCHEVES, BASIL S

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



Notice of Abandonment

Application No.

10/663,060

Applicant(s)

OKADA ET AL.

Examiner

Art Unit

Basil Katcheves

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. Applicant's failure to timely file a proper reply to the Office letter mailed on 18 January 2006.
 - (a) A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) No reply has been received.

2. Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) The issue fee and publication fee, if applicable, has not been received.

3. Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) No corrected drawings have been received.

4. The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

5. The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.

6. The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

7. The reason(s) below:

No response has been filed

Basil Katcheves
BASIL KATCHEVE
PRIMARY EXAMINER 103 635

8/3/06

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

30 Rockefeller Plaza
New York, NY 10112-4498
(212) 259-2595 (fax)

UNITED STATES PATENT & TRADEMARK OFFICE
FACSIMILE COVER SHEET

Date: September 6, 2006

Fax Number:.....571-273-8300

Pages (including cover sheet).....

Time Sent:.....approx.

FACSIMILE:.....(212) 259-2595 (AUTOMATIC-24 hours)

FOR ASSISTANCE:.....(212) 408-2500

Attn: Examiner Basil S. Katcheves

Group Art Unit: 3635

Applicants: Okada et al.

Application No.: 10/663,060

Attorney Docket No.: A35998 - 074224.0118

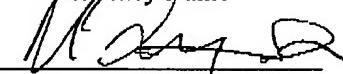
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PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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 Office on the date indicated below

<u>September 1, 2006</u> _____ Date of Deposit	<u>37,952</u> _____ PTO Reg. No.
 _____ Signature	<u>September 1, 2006</u> _____ Date of Signature

RESPONSE TO NOTICE OF ABANDONMENT

Commissioner for Patents
 Alexandria, VA 22313-1450

Sir:

Applicants request clarification of the Notice of Abandonment mailed August 15, 2006.

The Notice states "The application is abandoned in view of: [] Applicant's failure to timely file a proper reply to the Office Letter mailed on January 18, 2006." However, applicants are unable to determine which Office Letter is being referred to in the Notice. Our files and indeed USPTO's PAIR site does not indicate any Office Letter mailed on January 18, 2006. Applicants

A35998 - 074224.0118
PATENT

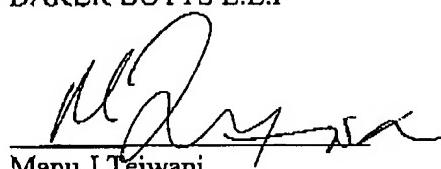
will appreciate a copy of this letter.

Applicants note that they have no intention of abandoning this application and have indeed filed a Request for Continued Examination on January 11, 2006. Further, applicants have filed a Petition To Withdraw Holding of Abandonment Under 37 C.F.R. 1.181(A) on January 11, 2006, a Renewed Petition on June 16, 2006, and a Second Renewed Petition on September 1, 2006. The last Petition, which is pending, includes in alternate, if necessary a requested petition for revival of the application under 37 C.F.R. § 1.137 (b).

Applicants will appreciate a copy of the Office Communication mailed January 18, 2006 so that they can properly respond to it and expedite prosecution of this application to patent issue.

Respectfully submitted,

BAKER BOTTS L.L.P



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